

Application No. 10:758,939  
Amendment dated January 29, 2007  
After Final Office Action of October 30, 2006

Docket No.: 28594/41530

### REMARKS

#### **I. Status of the Claims**

Upon entry of the instant amendment, claims 53, 55 and 57 are amended and claims 54, 56 and 58-78 are canceled. Claims 53, 55 and 57, as amended, are directed to a specific embodiment of the invention (i.e., a method of treating psoriasis comprising administering to a patient in need thereof a composition consisting essentially of two glycoalkaloids selected from the groups consisting of solamargine, solasonine, solanine, tomatine, solanocapsine and 26-aminofurostane and wherein the two glycoalkaloids are present in the composition at a ratio of between 1:4 and 1:1.) Support for the amended claims can be found throughout the application as filed and the original claims.

None of the amendments made herein were made for reasons pertaining to patentability but rather to expedite prosecution of this application. Applicant reserves the right to pursue the subject matter of any claim, as originally filed or amended, in continuing applications.

#### **II. The double patenting rejection is moot and should be withdrawn.**

The examiner rejected claims 53-78 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 31-35 and 44-49 of copending Application No. 11/143,043. First of all it should be noted that claims 31-35 and 44-49 of the copending application were canceled in response to the official action dated August 17, 2006. Further, the rejection is moot because the pending claims of the copending application are no longer directed to a method of treating psoriasis. Accordingly, the double patenting rejection should be withdrawn.

#### **III. The rejection under 35 U.S.C. § 112, first paragraph, is moot and should be withdrawn.**

The examiner rejected claims 66-78 as allegedly failing to comply with the written description requirement. Applicants believe that the subject matter of claims 66-78 is adequately supported by the specification as filed. However, in order to expedite

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prosecution, claims 66-78 have been canceled. Accordingly, the rejection is moot and should be withdrawn.

**IV. The rejection under 35 U.S.C. § 102(b), or in the alternative, under 35 U.S.C. § 103 (a) over Cham et al. should be withdrawn.**

The examiner rejected claims 1-65 under 35 U.S.C. § 102(b), or in the alternative, under 35 U.S.C. § 103 (a) over Cham et al. (Australian Patent No. 57853/80). Applicants respectfully request reconsideration of the rejection in view of the amendments made herein and the following remarks.

First, it should be noted that claims 1-52 were canceled in a previous amendment. Accordingly, the remarks below are directed to claims 53, 55 and 57. The remaining rejected claims have been canceled herein.

Claim 53 as amended herein expressly requires that the composition contains, as an active ingredient, a composition that consists essentially of two glycoalkaloids in a specific ratio. While Cham et al. discloses a composition that comprises solasonine (as 33% of the composition) and solamargine (as 33% of the composition), the composition also includes a third portion which was made up of di- and mono-glycosides and free sugar (rhamnose). The composition recited in independent claim 53 does not include this third portion. Accordingly, because the cited art discloses a method of treating psoriasis comprising administering a composition that requires additional components (i.e., di- and mono-glycosides and free sugar (rhamnose)) than the composition recited in claim 53, it cannot anticipate the method recited in claim 53 or any claim dependent thereon. Accordingly, the rejection under 35 U.S.C. § 102(b) should be withdrawn.

Further, one of skill in the art would not be motivated to modify the composition of Cham et al. to remove the additional components (i.e., di- and mono-glycosides and free sugar (rhamnose)), because doing so would go against the express teachings of the reference. Accordingly, there can be no *prima facie* case of obviousness based even in part on Cham et al.

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Moreover, Cham et al. discloses the use of BEC which is a plant extract containing solamarine, solasonine, their corresponding mono and di-glycosides, free sugars and aglucone. There is nothing in Cham et al. that teaches or remotely suggests that a composition consisting essentially of two glycoalkaloids, such as solarmargine and solasonine, would be suitable for treating psoriasis. Thus, it would not possible to determine with any confidence whether any components of BEC could be used to treat psoriasis or any other disorder.

In view of the above amendments and remarks, applicants submit that the claims as presented above are novel and non-obvious. Accordingly, the rejections should be withdrawn.

**V. The rejection under 35 U.S.C. § 103 (a) over Cham et al. (WO 91/10743 or WO 00/611153) is moot and should be withdrawn.**

The examiner rejected claims 66-78 under 35 U.S.C. § 103(a) as allegedly being obvious over Cham et al. (WO 91/10743 or WO 00/611153). This rejection is moot in view of the cancellation of the rejected claims. Accordingly, the rejection should be withdrawn.

#### **VI. Conclusion**

For the foregoing reasons, applicants request withdrawal of all outstanding rejections and allowance of the pending claims. No other fees are believed to be due with the filing of this paper. However, the Director is authorized to charge any additional fees deemed necessary to Deposit Account No. 13-2855, under order number 28594/41530.

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If the examiner believes that a telephone conversation would expedite allowance of the claims, she is invited to contact the undersigned agent or Nabeela R. McMillian, attorney for applicants, at the number below.

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Respectfully submitted,

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